

**REMARKS**

This is in reply to the Office Action of September 25, 1998. Therein, claims 1-96 were pending before the Examiner and claims 1-96 were rejected. Herein applicants amend claims 1, 6, and 39 and add claims 97-100. As such, with entry of the foregoing amendments, claims 1-100 will be pending for examination.

**I. Formal Matters**

Applicants wish to thank the Examiner for initialing applicants Form PTO-1449 submitted on June 8, 1998. Applicants note, however, that the box for PTO-1449s was not checked on the Office Action Summary page. Accordingly, applicants respectfully clarify for the record that the initialed form was attached to the instant Office Action.

**II. New Claims**

Applicants have added new claims 97-100. The recitation of "fertile" poinsettia plants can be found throughout the specification. In particular, support for this recitation can be found on page 1, line 5 in the description of "transgenic flowering plants" and in Example 8 which describes transgenic flowering poinsettia.

**III. Indefiniteness Rejections**

The Examiner has rejected claims 1-72 as indefinite. Applicants address each of the Examiner's grounds of rejections:

The Examiner has rejected claims 1, 6, and 39, on the grounds that the recitation "capable of" is vague and indefinite. Without acquiescing in the Examiner's position, applicants have obviated this rejection by deleting the objected to recitation. This amendment is made for clarification purposes and is not intended to limit the scope of the claims in view of the prior art.

The Examiner has rejected the claims specified on pages 2-3 of the Office Action on the grounds that the recitations "callus induction medium," "embryo induction medium," "developmental medium," and "maturation medium" are vague and indefinite. Applicants respectfully traverse this rejection.

The objected to recitations are clearly defined in the specification. "Callus induction medium" is defined, for example, on page 16 of the specification and representative ingredients are shown in Table 1 on page 19 of the specification. "Embryo induction medium" is described, for example, on page 16 of the specification and representative ingredients are shown in Table 2 on page 21 of the specification. "Developmental medium" is described, for example, on page 18 of the specification and representative ingredients are shown in Table 3 on page 24 of the specification. "Maturation medium" is described, for example, on page 17 of the specification and representative ingredients are shown in Table 4 on page 26 of the specification. In view of this description in the specification, applicants submit that these claim recitations would be clear to the skilled artisan.

The Examiner has rejected claims 6 and 39 as unduly alternative due to the recitation of steps in the alternative (c) and (c') and (h) and (h'). While applicants believe that the alternative format would be clear, applicants have replaced the (c) or (c') and (h) or (h') format with (c) (i) or (ii) and (h) (i) or (ii). Applicants submit that this alternative format would be clear to one of skill in the art.

Accordingly, applicants respectfully request reconsideration and withdrawal of the Examiner's indefiniteness rejections.

#### **IV. Art Rejections**

The Examiner has rejected claim 73 as anticipated by Cheetham, claims 74-96 as obvious over Cheetham, and claims 1-72 as obvious over Cheetham in view of Preil and Nataraja. Applicants respectfully traverse on the ground that Cheetham neither discloses nor enables transgenic plants and the secondary references fail to remedy this defect.

Although the authors in Cheetham attempted to regenerate shoots from cultured root explants, they never succeeded. It is clearly stated on page 513, under the header "3.3 Growth regulators" that "no shooting was ever observed." Accordingly, applicants submit that the reference fails to disclose a transgenic poinsettia plant.

Moreover, applicants have contacted, via email, Dr. P. Weathers, one of the named authors of the reference and inquired into whether the authors had to date achieved regenerated plants. Dr. Weathers responded that

We tried various regimens of hormones to get plant regeneration  
... No shoots were ever observed. We are no longer working  
on the problem.

Applicants have attached this communication in full as **APPENDIX A**. This communication shows that even to date the authors of the cited reference have been unable to achieve regenerated plants.

Applicants, submit, therefore, that Cheetham fails to disclose transgenic poinsettia plants, the reference fails to teach or enable the production of such plants. The secondary references cited by the Examiner fail to remedy this defect. Accordingly, applicants respectfully request withdrawal and reconsideration of the Examiner's art rejections.

**V. Conclusion**

Applicants submit that the claims are in condition for allowance in view of the above argumentation. If, however, the Examiner has any questions regarding the instant reply, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,

December 28, 1998  
Date

Richard C. Peet  
Richard C. Peet  
Reg. No. 35,792

Foley & Lardner  
3000 K Street, N.W.  
Suite 500  
Washington, D. C. 20007-5109  
(202) 672-5300